

- Application No. 09/891,517
Reply to Office Action of September 9, 2003

REMARKS

The Office has required restriction in the present application as follows:

- Group I: Claims 1-4 in total, claims 12, 14-17, and 29-36 each in part, drawn to probe set 1 as described in claim 1, and kits comprising those probes;
- Group II: Claims 5-7 in-total, claims 11, 12, 14-17, and 29-36 each in part, drawn to probe set 2 as described in claim 5, and kits comprising those probes;
- Group III: Claims 8-10 in total, claims 11, 12, 14-17, and 29-36 each in part, drawn to probe set 3 as described in claim 8, and kits comprising those probes;
- Group IV: Claim 13 in total, claims 14-17 and 29-36 each in part, drawn to probe set 4 as described in claim 13, and kits comprising those probes;
- Group V: Claim 18 in total, claim 48 in part, drawn to a first hybridization method measuring intensity of fluorescence;
- Group VI: Claim 19 in total, claim 40 in part, drawn to a second hybridization method measuring a change in fluorescence;
- Group VII: Claims 20-21 in total, claim 40 in part, drawn to a third hybridization method wherein high-order structures are degraded;
- Group VIII: Claims 22 and 41 in total, drawn to a fourth hybridization method determining polymorphism or mutation measuring a change in intensity of fluorescence;
- Group IX: Claims 23-28 and 42 in total, drawn to a fifth method, PCR-based;
- Group X: Claims 37-39 in total, drawn to a sixth method hybridization-based;
- Group XI: Claim 43 in total, drawn to a seventh method, PCR-based;
- Group XII: Claim 44 in total, drawn to an eighth method, PCR-based;
- Group XIII: Claim 45 in total, claim 47 in part, drawn to a ninth method, PCR-based;
- Group XIV: Claim 46 in total, claim 47 in part, drawn to a tenth method, PCR-based;
- Group XV: Claims 48-52 and 54, drawn to data analysis methods; and
- Group XVI: Claim 53, drawn to an eleventh method, a PCR method for analyzing a melting curve.

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Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. MPEP § 803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

The Office has characterized the inventions of Groups I-IV and V-XVI as being independent and distinct. However, Applicants note that the M.P.E.P. describes independent inventions as, for example, “an article of apparel such as a shoe, and a locomotive bearing”, or “a process of painting a house and a process of boring a well”. M.P.E.P. § 806.04(A). Thus, independent inventions, as defined by the M.P.E.P., are inventions which are directed to completely different technical fields, and have no reasonable relationship with each other. Applicants make no statement with regard to patentable distinctness of Groups I-IV and V-XVI, but respectfully submit that the Office has not shown how the inventions of these groups meet the standard of independent inventions of MPEP § 806.04(A). Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and request that it be withdrawn.

The Office has also characterized the inventions of Groups I-IV and V-XVI as related as product and process of use. The Office states that “each product has a multiplicity of uses as illustrated by the variety of methods being claimed for those products” and that “probes could also be used in diagnostic applications and for cloning sequences.” However, for restriction to be proper, M.P.E.P. § 806.05(h) requires that the process as claimed must be capable of practice with another “*materially* different” product and that the product as claimed must be capable of use in a “*materially* different” process (emphasis added). Applicants respectfully submit that the Office has failed to show that the alleged alternative

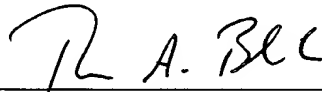
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uses proposed by the Office are *materially* different from those claimed. Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and request that it be withdrawn.

Accordingly, and for the reasons stated above, Applicants respectfully submit that the present application is now in condition for examination on the merits. Early consideration thereof is earnestly solicited.

Respectfully submitted,

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